IEV International Pty Ltd v Sadacharamani a/l Govindasamy

HIGH COURT (KUALA LUMPUR) — ORIGINATING SUMMONS NO (D7) D5–24–318 OF 2006
RAMLY ALI J
15 JANUARY 2008

Patents — Inventive step — Whether invention obvious to person skilled in art — Apparatus for the combating of marine growth on offshore structures — Whether defendant's invention offered any technical advancement or improvement

Patents — Novelty — Valid prior art — Publication in Malaysia — Whether defendant's device something new and had not been anticipated

The plaintiff applied pursuant to ss 33C, 56 and 57 of the Patent Act 1983, for an order to invalidate the defendant's patents No MY-119064-A (064 Patent) and MY-119147-A (147 Patent). The plaintiff had since 1988 been manufacturing in Malaysia certain products known as 'Apparatus for the Combating of Marine Growth on Offshore Structures'. The said products were designed and invented in 1986. The said products had been continuously developed since 1988 and had been manufactured, sold and installed in Malaysia and also exported worldwide for more than 19 years. The plaintiff alleged that the inventions of the defendant were not patentable as they did not comply with the requirements of the Patents Act 1983 particularly ss 11, 14, 15 and 16, and further that the rights to the said alleged inventions of the defendant did not belong to the defendant. The plaintiff argued that the defendant's inventions were not patentable as they formed part of the state of art and was anticipated by prior act before the priority dates of 3 September 1993 for the 064 Patent and 1 September 1993 for the 147 Patent and had been disclosed to the public including those in Malaysia. The defendant was also employed by the plaintiff as a marketing and contracts manager between January 1991 and December 1992 and had access to a wide range of confidential information and documents of the plaintiff relating to the plaintiff's products and patent. The defendant made various allegations concerning the products of the plaintiff and alleged improvements which he claimed were made by him to the products.

Held, allowing the plaintiff's application with costs:

(1) An invention is new if it is not anticipated by prior art. To determine whether the defendant's patents had been anticipated by the earlier patent of the plaintiff, it was necessary to compare the plaintiff's earlier publications or products with the defendant's later claim. The plaintiff's device or product must, for this purpose, be interpreted as at the date of its first use, having regards to the relevant surrounding circumstances which then existed, and without regards to subsequent events. The defendant's claim must similarly be construed as at its own date having regards to the relevant surrounding circumstances then existing (see para 25).

(2) The court observed that the defendant's patents did not portray any technical advancement or improvement and it was obvious that the alleged inventions of the defendant were mere workshop or superficial changes or common place design features made to the plaintiff's design, which would be selected without inventive activity by person skilled in the art from the normal design options available to them (see para 33).

(3) The expert evidence as tendered by the plaintiff, which had not been answered by any expert evidence at all by the defendant, clearly showed and supported the findings that there was no novelty of inventive step in the claims made in Patents No MY-119064-A and MY-119147-A of the defendant and as such the said patents were invalid (see para 34).

[Bahasa Malaysia summary

Plaintif memohon mengikut ss 33C, 56 dan 57 Akta Paten 1983, untuk satu perintah mentaksahkan paten defendan No MY-119064-A (064 Patent) dan MY-119147-A (147 Patent). Plaintif telah semenjak 1988 membuat produk-produk di Malaysia yang dikenali sebagai 'Apparatus for the Combating of Marine Growth on Offshore Structures'. Produk-produk tersebut direka dan dicipta pada 1986. Produk-produk tersebut telah secara berterusan dibangunkan semenjak 1988 dan telah dibuat, dijual dan dipasang di Malaysia dan juga dieksport ke serata dunia lebih daripada 19 tahun. Plaintif mengatakan bahawa rekaan-rekaan defendan tidak boleh dipatenkan oleh kerana mereka tidak mematuhi keperluan-keperluan Akta Paten 1983 terutama sekali ss 11, 14, 15 dan 16, dan selanjutnya hak-hak kepada kononnya rekaan defendan tidak dimiliki defendan. Plaintif menghujahkan bahawa rekaan defendan adalah tidak boleh dipatenkan oleh kerana mereka membentuk sebahagian daripada keadaan seni dan telah dijangkakan oleh seni yang terdahulu sebelum tarikh terdahulu 3 September 1993 untuk 064 Paten dan 1 September 1993 untuk 147 Paten dan telah didedahkan kepada orang awam termasuk di Malaysia. Defendan juga bekerja dengan plaintif sebagai pengurus kontrak dan pasaran

di antara Januari 1991 dan Disember 1992 dan telah mempunyai akses kepada pelbagai jenis maklumat sulit dan dokumen-dokumen plaintif berhubung dengan produk-produk dan paten plaintif. Defendan telah membuat berbagai dakwaan-dakwaan berhubung dengan produk-produk plaintif dan telah mengatakan bahawa pembaharuan telah dilakukannya terhadap produk-produk tersebut.

Diputuskan:

(1) Sesuatu ciptaan adalah baru sekiranya ia bukan satu yang telah dijangkakan oleh seni yang terdahulu. Untuk memastikan sama ada paten-paten defendan telah dijangkakan oleh paten yang terdahulu plaintif, ia adalah perlu untuk bandingkan terbitan-terbitan dan produk-produk plaintif terdahulu dengan tuntutan defendan yang kemudiannya. Kaedah atau produk plaintif seharusnya, untuk tujuan ini, ditafsirkan pada tarikh penggunaan pertamanya, setelah mengambil kira keadaan sekeliling yang wujud pada masa tersebut, dan tanpa mengira keadaan selepasnya. Tuntutan defendan juga seharusnya ditafsirkan pada tarikhnya sendiri setelah mengambil kira keadaan sekeliling yang wujud pada masa tersebut (lihat perenggan 25).

(2) Mahkamah memperhatikan bahawa paten-paten defendan tidak menggambarkan sebarang pendahuluan teknikal atau pembaharuan dan ia adalah jelas bahawa rekaan-rekaan defendan yang dikatakan itu adalah hanya pertukaran worksyop atau superfisial atau rekaan yang biasa terhadap ciptaan plaintif, yang dapat dipilih tanpa sebarang aktiviti yang berdaya cipta oleh seorang yang pakar dalam seni tersebut daripada pilihan yang biasa yang sedia ada (lihat perenggan 33).

(3) Keterangan pakar yang dikemukakan oleh plaintif, yang langsung tidak dijawab oleh mana-mana keterangan pakar defendan, jelas menunjukkan dan menyokong carian bahawa tiada pembaharuan dengan langkah rekaan dalam tuntutan yang dibuat oleh defendan di Patent No MY-119064-A dan MY-119147-A dan dengan itu paten-paten tersebut adalah tidak sah (lihat perenggan 34).]

Notes

For cases on novelty, valid prior art generally, see 10 *Mallal's Digest* (4th Ed, 2005 Reissue) paras 1118–1120.

For cases on whether invention obvious to person skilled in art, see 10 *Mallal's Digest* (4th Ed, 2005 Reissue) paras 1114–1115.

Cases referred to

Besalon International Ltd & Ors v South Strong Industries Sdn Bhd [1997] 2 MLJ 131 (refd)

A *Gadd and Mason v Mayor etc of Manchester* [1892] 9 RPC 516 (refd)
General Tine & Rubber Co, The v Firestone Tyre & Rubber Co Ltd [1972] RPC 457 (refd)
Hereafoam Asia Sdn Bhd v PF Techonology Sdn Bhd [2001] 2 MLJ 660 (refd)

B **Legislation referred to**
Patent Act 1983 ss 11, 14, 15, 16, 33C, 56, 57

C Soosamy Nathan (KS Moghan with him) (KS Moghan & Azlin) for the plaintiff.
PS Gill (Gill & Tang) for the defendant.

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Ramly Ali J:

THE APPLICATION

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[1] This is an application by the plaintiff pursuant to ss 33C, 56 and 57 of the Patent Act 1983, for an order to invalidate the defendant's patents No MY-119064-A ('064 Patent') and MY-119147-A ('147 Patent').

E **[2]** The plaintiff has by the present Originating Summons dated 28 August 2006 (encl 1) applied for the following reliefs, namely:

(a) that Malaysian Patent No MY-119064-A ('064 Patent') and Malaysian Patent No MY-119147-A ('147 Patent') and all the claims therein contained shall be regarded as null and void and hence unenforceable in
F Malaysia as of their respective dates of grant; and;

(b) that the Registrar of Patents, Malaysia do take steps within 14 days of the service of the ensuing order on him to record the fact of the said declaration in the Register of Patents and thereafter cause such fact to
G be additionally published in the Government Gazette.

[3] The grounds of this application (details of which are set out in the particulars of objection filed together with the originating summons) are that the alleged inventions of the defendant are not patentable as they do not
H comply with the requirements of the Patents Act 1983 particularly ss 11, 14, 15 and 16, and further that the rights to the above said alleged inventions of the defendant do not belong to the defendant.

[4] This application is supported by the Affidavit of Christopher Nghia Do
I affirmed on 25 August 2006 (encl 2), the affidavit of Stephen Haley affirmed on 9 June 2006 (encl 3) and the particulars of objection served with the originating summons.

[5] The defendant by his affidavit in reply affirmed on 26 October 2007 (encl 18) replied to the originating summons dated 28 August 2006 and to the affidavit of Christopher Nghia Do affirmed on 25 August 2006 (encl 2), the affidavit of Stephen Haley affirmed on 9 June 2006 (encl 3) and the particulars of objection dated 28 August 2006.

PLAINTIFF'S ARGUMENTS

[6] The plaintiff in its particulars of objection argued that the defendant's inventions are not patentable as they formed part of the state of art and was anticipated by prior act before the priority dates of 3 September 1993 for the 064 Patent and 1 September 1993 for the 147 Patent and had been disclosed to the public including those in Malaysia by reason of:

(a) 20 Drawings dated between June 1989 to June 1992 allegedly belonging to the plaintiff were disclosed to the public in Malaysia;

(b) five articles were published in various countries relating to the plaintiff's Malaysian Patent No MY-103283-A (283 Patent) entitled Apparatus for the Combating of Marine Growth on Offshore Structures;

(c) there were users before the priority dates of 1 September 1993 and 3 September 1993;

(d) by reason of grant of Patents before the priority dates in seven countries and in nine other countries after the priority dates of 1 September 1993 and 3 September 1993.

[7] The plaintiff claimed that those inventions involve no inventive steps because:

(a) they are obvious to persons having ordinary skill in the art;

(b) they offers no technical advancement or improvement;

(c) plaintiff used cleaning blades of a variety of rollers;

(d) adjustable slots to accommodate varying thickness in the plaintiffs marine growth preventers since 1987 but plaintiff discontinued use;

(e) 064 Patent exactly same as the plaintiff's MGP II save for cup with fin and gives no technical advantage.

[8] The plaintiff further argued that the rights to patent in relation to these inventions do not belong to the defendant because:

(a) defendant's claims fall within the scope of the 283 Patent;

(b) defendant was IEV SEA's Marketing and Contracts Manager between Jan 1991 and December 1992 and had access to manufacturing drawings and specifications installation instructions etc;

(c) defendant wrongly made use of documents and confidential informations;

(d) defendant knew at time of grant of the two Patents on 31 March 2005 and 30 April 2005 that he was not entitled.

DEFENDANT'S ARGUMENTS

[9] The defendant on the other hand claimed that none of his inventions and drawings in Patent 064 and Patent 147 in anyway resemble the plaintiff's inventions and drawings. The differences spotted by the defendant between the plaintiff's patent and the defendant's patents are as follows:

(a) the plaintiff is using floating ring and submerged rings with cleaning members with the semicircular head which does not resemble the defendant's rubber roller assembly and further uses the scraper blades on the linkages whereas the defendant's patent provides for the use of impact rubber roller constructed in the manner set out in his claims.

(b) The plaintiff's brush assembly is different from the defendant's rubber roller assembly and likewise the linkage restrainers used in the defendant's patent are not found in the plaintiff's who uses disk brushers in terms of their Patent. Even the cup fin was never claimed in their Patent but referred to in passing in the specifications of the plaintiff and is of a totally different design from that in defendant's designed one with elongated scoop like design.

(c) As the defendant's patents using the rubber rollers functions differently in that it not only hammers but wipes of the calcarious organisms from the structures by not only rotational movements but also by latereal movements along the shaft whereas the design of the plaintiff's MGR and MCP is by scraping action using the scraper blades and wire brushes. Further the defendant's designs allow the WDI to be installed onto structures which are not vertical and cup fins cause it to have negative lift so as to drive deeper.

[10] The defendant argued that with such a vast difference between the plaintiff's patent and the defendant's patent, there can be no infringement of the plaintiff's patent or design and accordingly the defendant's patent cannot be invalidated as prayed by the plaintiff.

[11] The defendant further argued that by going through each of the defendant's and plaintiff's patents the marine growth apparatus is not new

and no one can claim a patent to the exclusive use of an apparatus which is a flexible collar that surround a submerged member, and has floatation material attached to it or to cleaning bars per se but what they are entitled to claim is specific design of the cleaning bar and how it functions. The defendant's cleaning bar does not resemble the plaintiff's designs at all and neither do the linkage members or the connectors.

FACTUAL BACKGROUND

[12] The plaintiff has since 1988 been manufacturing in Malaysia certain products known as 'Apparatus for the Combating of Marine Growth on Offshore Structures'. The said products were designed and invented in 1986. The said products have been continuously developed since 1988 and have been manufactured, sold and installed in Malaysia and also exported worldwide for more than 19 years.

[13] The plaintiff had patented the serial products in Malaysia (Patent No MY-103283-A granted on 29 May 1993). The priority date for the plaintiff's Malaysia Patent is 15 May 1987. The plaintiff has also patented the said products in 14 other countries worldride, namely – Denmark, Australia, Europe/United Kingdom, Europe/Italy, Europe/Netherlands, Indonesia, Canada, China, OAP (Cameroon), United States, Maxico, Brazil, India and Nigeria.

[14] The plaintiff has used and published the inventions to the products of the plaintiff and disclosed to the public (including in Malaysia) as follows:

(a) by the drawings listed in pp 3 and 4 of the particulars of objection;

(b) by the articles published in Malaysia and in other countries highlighting the role of the plaintiff in inventing, developing and manufacturing marine growth removers and preventers as set out in the publications detailed in pp 4 and 5 of the particulars of objection;

(c) by the users in various parts of the world, before the priority date of the defendant's patents, as listed in pp 6 and 7 or the particulars of objection;

(d) by the 16 patents which were granted to the plaintiff before the priority date of the defendant's said patents, as listed on pp 7, 8 and 9 of the particulars of objection.

[15] The defendant was employed by the plaintiff as a Marketing and Contracts Manager between January 1991 and December 1992 and had access to a wide range of confidential informations and documents of the plaintiff relating to the plaintiff's products and patent. The defendant almost

immediately after resigning from the plaintiff ie 7 months, took steps to patent what he alleged was an improved product. The defendant filed his application for patents on 1 September 1993 (Malaysia Patent No MY-119147-A) and on 3 September 1993 (Malaysia Patent No MY-119064-A). The said patents of the defendant were granted after a lapse of 12 years, on 31 March 2005 and 30 April 2005 respectively. The defendant has not commenced manufacturing his alleged products.

SECTION 56 OF THE PATENTS ACT 1983

[16] Section 56 of the Patents Act 1983 provides:

56. Invalidation of patent:

(1) Any aggrieved person may institute court proceedings against the owner of the patent for the invalidation of the patent.

(2) The court shall invalidate the patent if the person requesting the invalidation proves:

(a) that what is claimed as an invention in the patent is not an invention within the meaning of s 12 or is excluded from protection under s 13 or subsection (1) of s 31 or is not patentable because it does not comply with the requirements of ss 11, 14, 15 and 16;

(b) that the description or the claim does not comply with the requirements of s 23;

(c) that any drawings which are necessary for the understanding of the claimed invention have not been furnished;

(d) that the right to the patent does not belong to the person to whom the patent was granted; or

(e) that incomplete or incorrect information has been deliberately provided or caused to be provided to the Registrar under subsection (4) of s 29A by the person to whom the patent was granted or by his agent.

(2A) Notwithstanding subsection (2), the Court shall not invalidate the patent on the ground mentioned in para (d) of subsection (2) if the patent has been assigned to the person to whom the right to the patent belongs.

(3) Where the provisions of subsection (1) apply on only some of the claims or some parts of a claim, such claims or parts of a claim may

be declared invalid by the court and the invalidity of part of a claim shall be declared in the form of a corresponding limitation of the claim in question.

[17] In the present application the plaintiff relied on s 56(1) and (2)(a) and (d) of the Patents Act 1983.

[18] Under s 56(1) of the Patents Act 1983 only 'an aggrieved person' may initiate proceedings against the owner of the patent for invalidation order. The words 'person aggrieved' has no special and technical meaning and should be liberally construed. The expression includes anyone who would be or in respect of whom there was a reasonable possibility of his being disadvantaged in a legal or practical sense by the Register being uncertified.

[19] Anyone who can show he is in some way prejudiced by the wrongful entry qualities as a person aggrieved. This can include, but is not limited to, a person who is carrying on trade in the same sort of goods as the articles for which the design is registered. The words 'person aggrieved' have been given a wide interpretation as including all persons who have a real practical interest in the issue. This does not necessarily equate with manufacturing rights so long as the plaintiff can show that it has a real practical or genuine interest beyond that of a mere busybody.

[20] It is not necessary for the 'persons aggrieved' to be the registered proprietor of a design. That person may simply have a genuine business or trading interest. This will include any person who has a legitimate trading interest within the territorial ambit of the registration, (see *Besalon International Ltd & Ors v South Strong Industries Sdn Bhd* [1997] 2 MLJ 131; and *Hereafoam Asia Sdn Bhd v PF Techonology Sdn Bhd* [2001] 2 MLJ 660).

[21] Under s 56(2)(a) of the Patents Act 1983, the plaintiff claimed that the invention in the defendant's Patents is not patentable because it does not comply with the requirement under ss 11, 14, and 15 of the same Act in that:

(a) the inventions of the defendant under Patents No. MY-119147-A and MY-119064-A are not new (absence of 'Novelty');

(b) the inventions of the defendant under Patents No. MY-119147-A and MY-119064-A do not involve an inventive step (absence of an 'Inventive Step').

A PATENTABLE INVENTION

[22] Section 11 of the Patents Act 1983 provides that 'an invention is patentable if it is new, involves an inventive step and is industrially applicable.

B INVENTION

[23] Section 12 of the same Act provides that:

(1) An invention means an idea of an inventor which permits in practice C the solution to a specific problem in the field of technology.

(2) An invention may be or many relate to a product or process.

NOVELTY

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[24] Section 14(1) and (2)(a) of the same Act provides that 'an invention is new if it is not anticipated by prior art' prior art shall consist of:

(a) everything disclosed to the public, anywhere in the world, by written E publication or by oral disclosure, by use or in any other way prior to the filing date or where appropriate, priority date of the patent application claiming the invention.

[25] An invention is new if it is not anticipated by prior art. To determine F whether the defendant's Patents have been anticipated by the earlier patent of the plaintiff, it is necessary to compare the plaintiff's earlier publications or products with the defendant's later claim. The plaintiff's device or product must, for this purpose, be interpreted as at the date of its first use, having regards to the relevant surrounding circumtances which then existed, and G without regards to subsequent events. The defendant's claim must similarly be construed as at its own date having regards to the relevant surrounding circumtances then existing. If the earlier plaintiff's device or products so construed discloses the same device as the device which the defendant by his claim, so construed, asserts that he has invented, the defendant's claim has H been anticipated, but not otherwise. In such circumtances the defendant is not the true and first inventor of the device.

[26] In the present case, the plaintiff claimed that the plaintiff has published articles between December 1990 and May 1991 in various I countries, including Malaysia, (before the priority date of the defendant's said patents) setting out the role of the plaintiff in inventing, developing and manufacturing the device or product in question. In *The General Tine & Rubber Co v Firestone Tyre & Rubber Co Ltd* [1972] RPC 457, the Court of Appeal (UK) held that:

> If the prior inventor's publication contains a clear description of, or clear instructions to do or make, something that would infringe the patentee's claim if carried out after the grant of the patentee's patent, the patentee's claim will have been shown to lack the necessary novelty, that is to say, it will have been anticipated. The prior inventor, however, and the patentee may have approached the same device from different starting points and may for this reason, or it may be for other reasons have so described their devices that it cannot be immediately discerned from a reading of the language which they have respectively used that they have discovered in truth the same device; but if carrying out the directions contained in the prior inventor's publication will inevitably result in something being made or done which, if the patentee's patent were valid, would constitute an infringement of the patentee's claim, this circumstance demonstrates that the patentee's claim has in fact been anticipated.

[27] If the defendant's device is not new and has been anticipated, then the device locks novelty, (the absence of novelty being commonly referred to as 'anticipation'). In *Gadd and Mason v Mayor etc of Manchester* [1892] 9 RPC 516 at 525, the Court of Appeal (UK) held as follows:

> In considering subject matter, novelty is assumed, the question is whether, assuming the invention to be new, it is one for which a patent can be granted. In considering novelty, the invention is assumed to be one for which a patent can be granted if new, and the question is whether on that assumption it is new. Has it been disclosed before? If there is an earlier specification for the very same thing the second invention is not new, but if the two things are different, the nature and extent of the differences have to be considered. The question becomes one of degree. But unless it can be said that the differences are practically immaterial, that there is no ingenuity in the second invention, no experiment necessary to show whether it can be successfully carried out or not the second cannot be said to have been anticipated by the first.

[28] In the present case, the court finds that the alleged inventions of the defendant formed part of the state of the art and was anticipated by prior art for the reasons that the inventions were already in use, made available and disclosed to the public in the following manner, namely:

(a) The plaintiff had issued the drawings in relation to the plaintiff's invention entitled 'Apparatus for the Combating of Marine Growth on Offshore Structures' between June 1989 and June 1992 as particularised in pp 2, 3 and 4 of the particulars of objection;

(b) Articles were written and published between December 1990 and May 1991 (all before the priority date of the defendant's said patents on 1 September 1993 and 3 September 1993) in various countries including Malaysia setting out the role of the plaintiff in inventing, developing and manufacturing marine growth removers and preventers as set out in pp 4 and 5 of the particulars of objection;

(c) The plaintiff's products and services relating to marine growth removers and preventers were used in the year 1991, 1992 and 1993, before the priority dates of the defendant's patents, in various parts of the world as set out in pp 6 and 7 of the particulars of objection;

(d) The plaintiff was also granted patents in 15 countries with regard to the 'Apparatus for the Combating of Marine Growth on Offshore Structures' as listed in pp 7, 8 and 9 of the particulars of objection and the matters disclosed in such patent were contained in the defendant's said patents. The priority dates of all of the matters in each of the patents were earlier than that of the priority dates of the defendant's said patents.

[29] The inventions claimed by the defendant in the defendant's patents therefore, are not new as they have been anticipated by 'prior art', as defined in s 14(2) of the Patents Act 1983.

[30] The court refers to the drawings in annexure A(1), (2) (3) and (4) and annexure B which show that the defendant's drawings as regards his alleged inventions in his said patents are almost identical to the plaintiff's drawings in the plaintiff's patent. The drawings relating to the plaintiff's products had also been published from the year 1991 in the magazines aforesaid.

INVENTIVE STEPS

[31] Under s 15 of the same Act, 'an invention shall be considered as involving an inventive step if, having regard to any matter which forms part of the prior art under para (a) of subsection (2) of s 14, such inventive step would not have been obvious to a person having ordinary skill in the art'.

[32] In this respect, the court refers to paras A, 1 (a), (b), (c) and (d) of the particulars of objection. After due consideration of the matters, the court is satisfied that the alleged inventions of the defendant would be obvious to a person having ordinary skill in the art having regard to the disclosures in the drawings referred to above, the articled published, and the users in various part of the would by the plaintiff of the marine growth removers and preventers before the priority dates of the defendant's patents.

[33] The court observes that the defendant's patents do not portray any technical advancement or improvement and it is obvious that the alleged inventions of the defendant are mere workshop or superficial changes or common place design features made to the plaintiff's design, which would be selected without inventive activity by person skilled in the art from the normal design options available to them.

[34] The court further finds that the expert evidence as tendered by the plaintiff, which has not been answered by any expert evidence at all by the defendant, clearly shows and supports the findings that there is no novelty of inventive step in the claims made in Patents No MY-119064-A and MY-119147-A of the defendant and as such the said patents are invalid.

THE RIGHTS TO THE PATENTS DO NOT BELONG TO THE DEFENDANT

[35] The plaintiff's Malaysian patent No MY-103282-A entitled 'Apparatus for the Combating of Marine Growth on Offshore Structures' was filed on 23 May 1988 and granted on 29 May 1993. The claims of the defendant's Patents which were filed in September 1993, fall within the scope of protection of the claims in the plaintiff's Malaysian Patent and are the same or essentially the same as the plaintiff's marine growth inventions.

[36] Between January 1991 and December 1992 the defendant was in the employment of EIV (SEA) Sdn Bhd as Marketing and Contracts Manager and thus had access to a wide range of confidential documents and information relating to the plaintiff's Malaysia Patent, such as manufacturing drawings and specifications, installation instructions, market survey information, pricing charts, lists of customers and production costs information.

EXPERT EVIDENCE

[37] The plaintiff has by the affidavit in reply affirmed by Christopher Nghia Do on 9 November 2007 (encl 19) replied to the various allegations made by the defendant. It is important to note that the application of the plaintiff is supported by the expert evidence of Mr Stephen Haley of Gill Jannings & Every LLP, Mr Peter J Finney of Gill Jennings & Every LLP and that of Mr Sahani bin Ahmad of the Intellectual Property Service Department of SIRIM Berhad.

[38] The expert, Mr Stephen Haley is a partner in Gill Jennings & Avery LLP, United Kingdom. He is a registered European Patent Attorney and Chartered British Patent Agent practicing as such since 1996. In his report, he states as follows:

> I have analysed the content of the specifications of granted Malaysian patents numbers MY-119147-A (hereinafter referred to as '147') and MY-119064-A (hereinafter referred to as '064') in relation to the patent MY-103283-A (hereinafter referred to as '283), which was published on 29 May 1993. This is before the priority date of 147, which was 1 September 1993 and the priority date of 064, which is 3 September 1993.

I have analysed the claims as they would be analysed under United Kingdom patent law and particularly the provisions of the 1977 UK Patents Act. In summary, it is my opinion that at least claims one of both 147 and 064 lack novelty over the disclosure in 283.

Before providing detailed analysis of the above-mentioned Malaysian patent it is probably appropriate to set out certain general principle of United Kingdom law and note that such principles are followed in numerous other jurisdictions, one of which I understand to be Malaysia. In general terms, a granted patent is only valid if the subject matter for which it has protection, as defined by its claims, has not been disclosed publicly anywhere prior to the earliest priority date of the patent, and the subject matter of the claims of that patent is not obvious in view of the fact that it has been disclosed publicly anywhere prior to the priority date of the disputed patent. It is also a general principle that other criteria. in terms of the subject matter not being that excluded by patent protection, are met, although it is my opinion that this issue is not relevant in this particular matter.

[39] The next expert, Mr Sahani bin Ahmad is a Senior Consultant for Intellectual Property Services in SIRIM Berhad (an independent body set up by the Government of Malaysia to provide expert consultancy on Intellectual Property matters including patent matters). He has a Masters degree in Intellectual Property Law from Franklin Pierce Law Centre, United States of America, and was a patent examiner with SIRIM Berhad from 1986 to 1996 and has been practicing as a registered patent agent since 2000.In his expert report, Mr Sahani bin Ahmad states as follows:

[40] In his expert report, Mr Sahani bin Ahmad states as follows:

Validity analysis is carried out by analyzing claims of both of the above patents to see whether they are novel and inventive over a prior art. In the present case the closest prior art is MY-103283-A entitled 'apparatus for combating marine growth on off-shore structures' (hereinafter referred to as 283 patent) irregardless of whether the 283 patent is valid or not as the publication of the 283 patent and the practice that follows would amount to a disclosure under the Patents Act, 1983. Aso considered as prior art is 'Technical report on pilot project of IEV's marine growth control products on ARCO's BRAVO and MIKE-MIKE platforms' published on 17 June 1991 (hereinafter referred to as the report). The drawings (hereinafter referred to as the drawing) contained in the report is referred.

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platforms' published on 17 June 1991 (hereinafter referred to as the report). The drawings (hereinafter referred to as the drawing) contained in the report is referred.

A. MY-119 064 (hereinafter referred to as 064 patent)

ANALYSIS OF CLAIMS

1. Claim 1 of 064 patent comprises of a few disjunctive sentences. This causes ambiguity that leads to uncertainty in determining the scope of protection sought. In many jurisdiction this type of claim is not allowed and a patent will not issue based on the claim, see Leonard's Application (1996) 12 RPC.

   The following analysis is carried out based on teachings of the description and the drawings rather than scope of protection of Claim 1.

   064 patent discloses a marine growth inhibitor consisting of a plurality of inhibiting rings held together to form a cage by a plurality of linkage members. The cage comprises a plurality of inhibiting brush assembly (4), linkage members (6), short shaft (5) (equivalent to a bolt and nut), connector (43) and cup fins (10).

   The 283 patent discloses an apparatus capable of functioning as marine growth inhibitor having a plurality of inhibitors rings (2, 3) held together by a plurality of linkage member (4) to form a cage (see FIG 1). The cage further comprises a inhibiting brush assembly (17, 18) and a linkage member (19) see FIG 9, and bolt and nut (5) and a connector (7) see FIG 2. No cup fin is disclosed in the 283 patent.

   However, the drawing contained in the report shows an identical device having all of the above features and the cup fin.

   Therefore 064 patent is fully anticipated by the drawing and thus lacks novelty.

2. Claims 2-16 of 064 patent are merely workshop practices that are neither novel nor inventive.

3. Claim 17 and 18 of 064 patent claim the cup fin that is disclosed in the drawing of the report and thus not novel.

4. Claim 19 of 064 patent claims buoyancy of a material Buoyancy is an inherent property of a material and is therefore not claimable.

5. Claims 20–23 or 064 patent are merely workshop practices that a neither novel nor inventive.

   064 patent is clearly anticipated by prior art and is therefore not valid.

B. MY-119 147 – A (hereinafter referred to as 147 patent)

ANALYSIS OF CLAIMS

1. Claim 1 of 147 patent claims a wave driven marine growth eliminator having a series of cleaning rings, one floats on the water and the rest kept submerged, the cleaning rings are held together by linkage members to form a cleaning cage installed encircling the submerged structures, the cleaning cage is characterized by a series of cleanings ring made up of a plurality of cleaning members, a plurality of zero moment connectors, a plurality of flexible joint and a plurality of linkage members.

The 283 patent (see FIG 1 and FIG 2) discloses an apparatus capable of functioning as a wave driven marine growth remover/eliminator (1) having a series of cleaning ring (2, 3), one floats (2) on the water and the rest kept submerged (3), the cleaning rings are held together by linkage members (4) to form a cleaning cage installed encircling the submerged structures, the cleaning cage is characterized by a series of cleaning rings (2, 3) made up of a plurality of cleaning members (10), a plurality of zero moment connectors (7), a plurality of flexible joint (6, 7) and a plurality of linkage members (4).

Claim 2 is dependent on Claim 1 which is not novel and is thus unallowable. Further Claim 2 claims a cleaning member having a hollow member filled with polystyrene having one side fixed with an impact roller and the other side with a float. FIG 2 of the 283 patent discloses a cleaning member having an impact roller (10) and a float (8). To use polystyrene as float means is neither novel nor inventive.

Claims 3–7 of 147 patent are merely workshop practices and dependent claims that are neither novel nor inventive.

therefore is neither novel nor inventive.

Claims 9–12 of 147 patent are merely workshop practices that are neither novel nor inventive.

Claims 13 of 147 patent claims that the impact roller may be replaced with a roller brush made from plastics bristles. This is disclosed in the 283 patent, see FIG 9, therefore not novel.

Claims 14–17 of 147 patent are merely workshop practices that are neither novel nor inventive.

147 patent is clearly anticipated by prior art and is therefore not valid.

CONCLUSION

From the above analysis, it is clear that the claims of MY-119 064 and MY – 119 147 – A are neither novel nor inventive and thus both of the said patents are invalid.

[41] The third expert witness Mr Peter J Finney's is a partner in Gill Jennings & Avery LLP United Kingdom. He is a registered European Patent Attorney and a Chartered Patent Attorney. He has previously acted as an expert witness in a separate patent case in Malaysia. In his report this expert witness says as follows:

the IEV patent as a prior publication are fundamentally flawed. It the defendant's assertion was correct, no prior published patent application would be considered as prior art until such time as the validity of the associated claims had been determined by a court. This is manifestly absurd.

The assertion by the defendant that Mr Haley's opinion is a comparison of the claims of IEV's patent and the claims of the defendant's patent is wholly incorrect. The opinion instead relates to the patentability of the defendant's claims in view of the disclosure through prior publication of the IEV patent application. This prior publication is not limited to the subject matter of the claims.

Accordingly, the validity of IEV's claims is an irrelevant issue in this case. This is a fundamental point of patent law across the world and for this reason the defendant's argument is wholly unfounded – indeed I am astonished they have run this argument. The validity of the prior art is an entirely separate issue to that of disclosure, and cannot be taken into account when considering the novelty and/or inventive step of the claims of the defendant's patent. In this respect, any publication of IEV's foreign patent applications that occurred before the priority dates of the defendant' s Malaysian patent is also valid prior art.

[42] These three expert witnesses produced by the plaintiffs are experts knowledgeable in their respective fields. Their evidence are not effectively rebutted by the defendant. The defendant has not given any expert evidence to show the validity of the defendant's patents or to contradict what the plaintiff's experts have reported. That being the case, there is not reason for this court not be accept their evidence. This evidence, to some extent have given guidance to the court in maters which involve some technicalities.

[43] The defendants in his affidavit affirmed on 26 October 2007, sought to rely on the opinions of Mr Wong Sai Fong of Messrs Shearn Delamore & Co and of one Mr David Hardisty. It must be noted that the opinion of Mr Wong Sai Fong and that of Mr David Hardisty were given more than 10 years ago in the proceedings begun by the defendant in 1994 to invalidate

the patent of the plaintiff (that is, the originating summons no D4-24-44 of 1994, known as the invalidation action). It must further be noted that:

(a) The invalidation action, to invalidate the plaintiff's patent filed in 1994 has no relevance to the present action of the plaintiff, which is to invalidate the defendant's patents which were only granted in 2006;

(b) The defendant has in fact filed an action alleging negligence on the part of Mr Wong Sai Fong/Messrs Shearn Delamore & Co. The defendant has alleged that the said solicitors were negligent in giving their opinion to the defendant. The defendant now seeks to rely on this same opinion (given more than 10 years ago) which has nothing to do with the issue of the validity of the patents of the defendant.

ALLEGATIONS BY THE DEFENDANT

[44] The defendant has made allegations concerning the validity of the plaintiff's Patent and has referred to the invalidation action (OS No D4-24-44 of 1994) and to the invalidation order made on the 13 November 1995 with regard to the plaintiff's patent. It is a fact that the plaintiff has on the 18 August 2005 obtained a clarification order in the invalidation action declaring that the invalidation order has been set aside and negated. The defendant or his company, Maelstorm Resources Sdn Bhd did not appeal from the clarification order, however, the defendant now chooses to make various allegations concerning the same. The court in satisfied that in any event the validity of the plaintiff's patent is not in issue in the present proceedings, the matter in issue is the validity of the defendant's patents.

[45] The plaintiff in any event has given evidence to show that the plaintiff has had 15 patent filed since 1988 and subsequently granted to the plaintiff in Denmark, Australia, United Kingdom, Italy, Netherlands, Indonesia, Canada, China, Cameroon, United States, Mexico, Brazil, India, Nigeria and Malaysia. The allegation which have been made by the defendant pertained substantially to the plaintiff's Malaysian patent. The fact is that all the other aforesaid patents of the plaintiff were filed since 1988 and would go to show that there was publication of all these patent applications which accurred before the priority date of the defendant's patents (being 1 September 1993 and 3 September 1993) and which constitutes prior art.

[46] The defendant has made various allegations concerning the products of the plaintiff and alleged improvements which he claims were made by him to the products. The plaintiff by the evidence of the three experts aforesaid has clearly shown that these alleged improvements were only workshop changes which did not make the claims of the defendant novel or inventive. The plaintiff has also given evidence to show that the plaintiff has at all

material times been using different materials including rubber. The court is of the view that these allegations are made merely to confuse the issues as the defendant has no grounds to show the validity of the defendant's patents and as such he chooses to attack the validity of the plaintiff's patent which is not in issues before this court. Mr Peter Finney, giving expert evidence on behalf of the plaintiff says that '… in this respect, any publication of IEV's foreign patent applications that occurred before the priority dates of the defendant's Malaysian patent is also valid prior art.

CONCLUSION

[47] Having carefully considered the evidence for both the plaintiff and the defendant as well as the submissions by counsels from both sides, it is the court's finding that the device in question was already in use in Malaysian as well as thought out the word and obvious, well before the filing of the application for the defendant's patent on 1 September 1993 and 3 September 1993 respectively (which were granted on 31 March 2005 and 30 April 2005 respectively. There is no novelty in the defendant's said devices when they were applied for registration. The defendant is not the original inventor of the said devices.

[48] The plaintiff's products or devices have been in use since 1988, manufactured in Malaysia, installed in Malaysia and in other countries since then and as such the claims of the defendant in his patents which were only filed in 1993 were anticipated by prior use as well as by written publications distributed internationally and in Malaysia and by the drawings and patent specifications published by the plaintiff before the priority date of the defendant's patents.

[49] That being the case, the court rules that the defendant's patents are not patentable because they do not comply with the requirements of ss 11, 14 and 15 of the Patents Act 1983 and that the rights to the patents do not belong to the defendant.

[50] Based on the above considerations, the court concludes that the plaintiff's application (vide originations summons encl 1) is allowed with costs.

Plaintiff's application allowed with costs.

Reported by Sally Kee